

REMARKS

Summary of the Examiner's Actions

The examiner rejected Claims 35 and 38 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. Applicant acknowledges the rejection under 35 U.S.C. § 112, second paragraph.

The examiner rejected Claims 1-38 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-35 of Hilliard, et al., U.S. Patent 6,590,400 ("Hilliard").

The examiner rejected Claim 36 under 35 U.S.C. § 102(b) as being anticipated by Toppeto, U.S. Patent 4,263,549 ("Toppeto"). Applicant acknowledges the rejection under 35 U.S.C. § 102(b).

The examiner rejected Claim 36 under 35 U.S.C. § 103(a) as being obvious under Toppeto in view of Kogure, U.S. Patent 5,469,156 ("Kogure"). Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

Rejections under 35 U.S.C. § 112, second paragraph

The examiner rejected Claims 35 and 38 under 35 U.S.C. § 112, second paragraph. Specifically, the examiner stated that there was no antecedent basis for the limitation "resistance-inductance-capacitance" in Claims 35 and 38. The phrase does not appear in Claim 35 but does appear in Claims 36 and 38. Applicant has amended Claims 36 and 38 to remove the limitation introduced through typographical error. Accordingly, the examiner's rejections under 35 U.S.C. § 112, second paragraph, have been traversed.

Double Patenting Rejection

The examiner rejected Claims 1-10 under the judicially created doctrine of obviousness-type double patenting. Submitted herewith is a Terminal Disclaimer in

compliance with 37 C.F.R. § 1.321(c). Accordingly, the examiner's double patenting rejection has been traversed.

Rejections under 35 U.S.C. § 102(b)

Section 2131 of the Manual of Patent Examining Procedure describes the basis for anticipation under 35 U.S.C. § 102. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Toppeto does not disclose each and every element of Claim 36 arranged as required by Claim 36. The examiner equates lines 24 and 26, shown in Figure 1 of Toppeto, with a pair of driver circuits. Toppeto discloses that "[l]ines 24 and 26 continue from terminals 35 and 37 through the probe 12 to the equipment 50 being tested." Toppeto, Col. 3, Lines 10-12. As specified by the examiner, the elements (lines 24 and 26) from Toppeto identified as the "pair of driver circuits" are inductively coupled with the probe, the element identified as corresponding to a wire-loop. Further, it is clear that Toppeto discloses lines 24 and 26 as connectors ("lines"), not driver circuits.

Continuing the analysis, Toppeto discloses a line impedance stabilizing network (LISN) 10. Toppeto states that "[t]he LISN serves to normalize the impedance [sic] of the power source at the vicinity of 3 ohms for power frequencies scaling up to about 150 ohms at radio frequencies. It also serves to reduce or filter out RFI in the power input so as to restrict the testing to noise generated only within the equipment under test." Toppeto, Col. 3, Lines 13-18. Thus, Toppeto attributes two functions to the LISN 10 (normalization and filtering). Accordingly, the disclosure of Toppeto does not support the examiners suggestion that the LISN 10 corresponds to a demodulation circuit. Even assuming that the LISN 10 of Toppeto could be construed as performing

demodulation, the LISN 10 and the filter 14 are part of two different circuits that are only inductively coupled through probe 12.

The examiner has failed to establish a *prima facie* case of anticipation as Toppeto does not disclose each and every element of Claim 36 arranged as required by Claim 36. First, the examiner has attempted to substitute an “inductive” connection for an “electrical” connection. Accordingly, the elements from Toppeto selected by the examiner are not arranged as required by Claim 36. Second, the examiner is attempting to substitute elements from Toppeto for non-analogous elements in Claim 36, e.g., a normalizing filter circuit for a demodulation circuit and a line for a driver circuit. Accordingly, Toppeto does not disclose all of the elements required by Claim 36. As the examiner has failed to properly establish a *prima facie* case of anticipation, Applicant respectfully requests that the examiner withdraw the rejections under 35 U.S.C. § 102(b).

Rejections under 35 U.S.C. § 103(a)

In order to support a rejection under 35 U.S.C. § 103(a), “the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP § 2142, pg. 2100-121, 8th ed. “To reach a proper determination under 35 U.S.C. § 103(a), the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.” *Id.* The first element in establishing a *prima facie* case of obviousness is that “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.” MPEP § 2143, pg. 2100-122, 8th ed. The second element is that there “must be a reasonable expectation of success.” *Id.* The third element is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *Id.*

For the reasons presented above in the response to the rejection under 35 U.S.C. § 102(b), Applicant respectfully submits that Toppeto, in combination with Kogure, fails to teach all of the claimed limitations of Claims 1, 37, and 38, the third element of a *prima facie* case of obviousness.

Notwithstanding, the examiner has failed to show any suggestion or motivation to combine the Toppeto and Kogure references, the first element of a *prima facie* case of obviousness. Generally, the examiner states that “it would have been obvious to one of ordinary skill in the art to modify Toppeto et al. [sic] by adding A/D converter disclosed by Kogure for processing measured signals by microprocessor (column 5 lines 15-20) for calculating loop inductance.”

First, such statement is conclusory and not properly based upon common knowledge. Therefore, the examiner’s statement cannot be relied upon to reject the claims without an explanation of the supporting rationale. See MPEP § 2144.03, pg. 2100-131 to 133. Accordingly, Applicant requests the examiner to support the finding with adequate evidence.

Second, the examiner’s statement is overly broad. Innovation often results from the combination of known elements in novel applications. Applicant appreciates that it is not uncommon to use an analog-to-digital converter (ADC) to facilitate the digital processing of analog measurements. However, the mere existence of an ADC in a patent disclosure does not automatically provide a suggestion or motivation to combine references. Were that the case, the examiner would merely need to pull a data sheet for an ADC and assert that common knowledge justifies the combination of a data sheet and a patent reference. Simply adding an ADC to the disclosure of Toppeto does not produce the invention of Claims 1, 37, or 38. In the instant case, Toppeto discloses noise reduction circuitry used with a current probe and Kogure discloses taking data from a physical sensor (pressure, temperature, flow rate, etc.), see Kogure, col. 4, lines 50-53, multiplexing the sensor data, and digitizing it using an ADC, see Kogure, col. 5, lines 11-19. Kogure even includes a demodulation circuit 113. What is missing is a showing by the examiner as to why anyone would look at Toppeto and Kogure and be motivated to move the ADC from Kogure into the apparatus of Toppeto. See MPEP § 2145(X)(C), pg. 2100-156.

Third, Toppeto and Kogure are non-analogous art and the inventions described therein have different purposes. It is not readily apparent that the inventions could be combined with any reasonable expectation of achieving the end result described in Claims 1, 37, or 38, the second element of a *prima facie* case of obviousness. When

one considers that Kogure is not related to inductive measurement and Toppeto attempts to remove noise when using a current probe, Toppeto and Kogure are not-analogous with respect to the present claims and it appears unreasonable to assume that combining Toppeto and Kogure would result in a device reading on Claims 1, 37, or 38, as suggested by the examiner.

As the examiner has failed to properly establish a *prima facie* case of obviousness, Applicant respectfully requests that the examiner withdraw the rejections under 35 U.S.C. § 103(a).

Summary

In view of the amendment of Claims 36 and 38, the submission of a terminal disclaimer, and the arguments presented herein, it is believed that the above-identified patent application is in a condition for the issuance of a Notice of Allowance. Such action by the examiner is respectfully requested. If, however, the examiner is of the opinion that any of the drawings or other portions of the application are still not allowable, it will be appreciated if the examiner will telephone the undersigned to expedite the prosecution of the application.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 16-1910.

Respectfully submitted,



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